

Applicant : Ren-Chang Huang et al.  
Serial No. : 10/697,782  
Filed : October 30, 2003  
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Attorney's Docket No.: 11702-003005 / PE-21602-1AM

### REMARKS

This document is filed in reply to the Office Action dated June 10, 2005 ("Office Action"). Applicants have amended the Specification to update the status of the parent application. Applicants have also narrowed claim 1 by incorporating the limitation recited in claim 2, necessitating cancellation of claim 2. Further, Applicants have amended claims 6-8 and 26 to promote clarity, and cancelled claims 9-15 and 27. No new matter has been introduced.

Upon entry of the above proposed amendments, claims 1-8 and 26 will be under examination. Reconsideration of this application is requested in view of the following remarks:

#### Double patenting

The Examiner rejected claims 1-15, 26, and 27 under the judicially created doctrine of obviousness-type double patenting on the ground that they are unpatentable over claims 1, 12, 14, and 16-19 of U.S. Patent No. 6,767,543 ("the '543 patent"). See the Office Action, page 2, lines 6-9.

Applicants disagree. According to MPEP,

#### **804.01 Prohibition of Double Patenting Rejections Under 35 U.S.C. 121**

...

The third sentence of 35 U.S.C. 121 prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent.

In this case, the instant application is a divisional application of U.S. Application Serial No. 10/113,903 ("the '903 application"), which has now issued into the '543 patent. That is, the '543 patent is "a patent issuing on [the '903] application with respect to which a requirement for restriction has been made." Thus, the Examiner erred in citing the '543 patent "as a reference

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against [the present] divisional application" for the double patenting rejection. Applicants respectfully request that this rejection be withdrawn.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 1-15, 26, and 27 for being indefinite. See the Office Action, the paragraph bridging pages 3 and 4. Applicants respectfully traverse and discuss independent claim 1 first.

Previously presented claim 1 is drawn to a process for producing an *Antrodia camphorata* culture that has a pharmacological activity. The method requires (i) subjecting an *Antrodia camphorata* culture to a first stage of agitation that is set at a first predetermined rate and for a first period of time and (ii) subjecting the culture thus obtained to a second stage of agitation that is set at a second predetermined rate different from the first predetermined rate. According to the Examiner, the claim "fail[s] to particularly point out and distinctly claim the subject matter which applicant regards as the invention with respect to [what are] the 'first predetermined rate' and 'second predetermined rate'."

Applicants would like to point out that claim 1 inherently sets forth the meaning of the terms at issue. See the recitations "a first stage of agitation which is set at a first predetermined rate" and "a second stage of agitation which is set at a second predetermined rate different from the first predetermined rate." In other words, the two terms refer to two different agitation rates used in two different stages. The Specification also describes in detail the two predetermined agitation rates. It further discloses a number of preferred agitation rates. See page 9, line 12 to page 10, line 19.

In this connection, Applicants note that "[w]hether a claim is invalid for indefiniteness depends on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the Specification." *North American Vaccine Inc. v. American Cyanamid Co.*, 28 USPQ2d 1333 (Fed. Cir. 1993). Here, one skilled in the art, when reading the claims in the light of the specification, would be reasonably apprised of the scope of the two agitation rates used to practice the process of claim 1. Thus, contrary to the Examiner's assertion, claim 1

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"point[s] out and distinctly claim[s] the subject matter which applicant regards as the invention with respect to [what are] the 'first predetermined rate' and 'second predetermined rate'." In the sole interest of moving this case toward allowance, Applicants have amended claim 1 to specify that the second predetermined rate is higher than, not just different from, the first predetermined rate.

The Examiner also asserted that it is not clear "[w]hat is 'period' in the expression of 'period of time' that is necessary to obtain the second stage." See the Office Action, page 4, lines 2 and 3. It appears to be the Examiner's position that claim 1 is indefinite for not reciting a specific time duration for culturing *Antrodia camphorata*. Applicants would like to remind the Examiner that

It is the function of the descriptive portion of the specification and not that of the claims to set forth operable proportions and similar process parameters and that claims are not rendered indefinite by the absence of the recitation of such limitations." Ex parte Jackson, 217 USPQ 804 (POBA 1982). 2).

Here, a period of time for culturing *Antrodia camphorata* is just a parameter for the process of claim 1, and a specific value thereof needs not to be recited in this claim. Thus, claim 1 is not rendered indefinite by the absence of the recitation of a specific time duration. (Incidentally, the Specification provides both general guidance and actual examples regarding the parameter of period of time. See, e.g., the Specification, page 9, last paragraph; and Examples 1-6 at page 14, line 1 to page 23, line 5.)

For the reasons set forth above, Applicants submit that claim 1 meets the definiteness requirement. So do claims 2-8 and 26, all which depend from claim 1 and further specify the process of claim 1.

The Examiner rejected claims 9-15 and 26 on the same grounds discussed above. Applicants have cancelled these claims, thereby rendering the rejection moot.

In view of the remarks and amendments, Applicants submit that the rejections should be withdrawn.

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CONCLUSION

Applicants submit that the rejections asserted by the Examiner have been overcome. On this basis, it is submitted that allowance of this application is proper, and early favorable action is solicited. Please apply any other charges deposit account 06-1050.

Respectfully submitted,

Date: \_\_\_\_\_

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